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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/715,871 | 11/17/2003 | John M. Epley | J-EPLY.1002 | 5600 |
| 56703 | 7590 | 10/23/2006 | EXAMINER | |
| ROBERT D. VARITZ, P.C. 4915 SE 33RD PLACE PORTLAND, OR 97202 | | | HOEKSTRA, JEFFREY GERBEN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3736 | |

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/715,871 | Applicant(s) EPLEY, JOHN M. | |
| | Examiner Jeffrey G. Hoekstra | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 08/17/2006, amended claim(s) 1, 6, and 7 is/are acknowledged. The following reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Densert et al (US 6,159,171) as broadly as structurally claimed.

4. For claims 1, 7, and 20-23, Densert et al discloses a head stabilized medical device (1), comprising:

- a stabilized head-dependent wearable frame structure (2) as best seen in Figures 1 and 2;
- plural different vestibular-parameter measuring/ modifying vestibular-parameter data delivering and data receiving devices (elements 19,20,28 and 30) anchored to said frame; and
- a communication structure (the wires as seen in Figures 1-2), for operatively connecting, transmitting and receiving, vestibular-relevant parameter data devices to a computer structure (29) (column 4 lines 49-52) capable of executing real-time

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vestibular diagnosis/treatment algorithms with feedback responses (column 7 lines 3-6) effective to alter air-pressure stimuli.

5. For claims 2 and 8, Densert et al discloses air-pressure modifying vestibular measuring/modifying devices (column 1 lines 6-48).

6. For claims 3-6, Densert et al discloses a sound delivering device creating pressure waves through air removably insertable into the ear comprising a tubular body (24) with a tapered insertion bulb or nozzle (25) effective to sealably engage the ear, and capable of piercing the tympanic membrane, and having a digitally manipulated maneuverable enlargement region (17 and 18) connected to said body at a proximal location of the inserted end.

Response to Arguments

7. Applicant's arguments filed 08/17/2006 have been fully considered but they are not persuasive. Applicant argues Densert et al (a) teaches nothing whatsoever about vestibular function testing of a test subject, (b) does not teach feedback and control based upon patient response to stimuli, and (c) fails to teach any tympanic membrane-piercing member or fluid delivery therethrough.

8. In response to applicant's argument (a) that Densert teaches nothing whatsoever about vestibular function testing of a test subject, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

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claim. In addition, the examiner notes pressure and temperature are vestibular-relevant parameter data.

9. In response to applicant's argument (b) that Densert does not teach feedback and control based upon patient response to stimuli, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

10. In response to applicant's argument (c) that Densert fails to teach any tympanic membrane-piercing member or fluid delivery therethrough, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lattner et al (US 6,314,324 B1) discloses structure for the measurement and modification of vestibular relevant parameter data.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

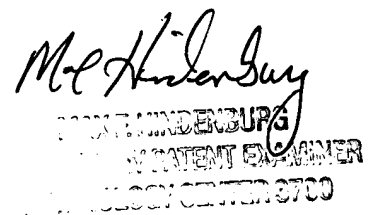
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH



MICHAEL H. L. G.
PATENT EXAMINER
TECHNOLOGY CENTER 3700